



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/879,825	06/12/2001	Craig W. Barnett	23419-003-409	4591

29315 7590 11/13/2002

MINTZ LEVIN COHN FERRIS GLOVSKY AND POPEO PC
12010 SUNSET HILL ROAD
SUITE 900
RESTON, VA 20190

EXAMINER

DURAN, ARTHUR D

ART UNIT	PAPER NUMBER
----------	--------------

3622

DATE MAILED: 11/13/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/879,825

Applicant(s)

BARNETT ET AL.

Examiner

Arthur Duran

Art Unit

3622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 June 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 47-60 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 47-60 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

DETAILED ACTION

1. Claims 47-60 have been examined.

Interference

2. Applicant's provocation of an Interference with Patent 6,076,069 has been noted.

However, claims 47-60 are rejected as stated below. Therefore, an Interference has not been initiated.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claim 52 rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claim 52 discloses a coupon that includes a cookie. However, nowhere in applicants specification is a cookie disclosed.

Claim 57 rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claim 57 feature D discloses 'the client requesting information from said

Art Unit: 3622

subsequent server'. However, nowhere in applicants specification is this information requesting step involving the subsequent server disclosed.

Claim 58 rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claim 58 discloses 'the server receives a request for information from the client prior to establishing a connection over a communications channel between a client and a server'. However, nowhere in applicants specification is this information requesting step prior to establishing a connection between the client and server disclosed.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in-

(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or

(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

4. Claims 47-51, 53-57, and 59-60 are rejected under 35 U.S.C. 102(e) as being unpatentable over Larson (5,708,782).

Art Unit: 3622

Claims 47 and 57: Larson discloses a system for dispensing discount coupons. Larson further discloses a first server system including a computer processor and associated memory (col 6, lines 20-27 and col 6, line 37-56), said first server system being connected by a communications channel to a client system, said first server system being adapted for transmitting an electronic coupon to said client system over said communications channel (col 1, lines 54-57; col 4, lines 33-36; col 6, lines 20-27; and col 6, line 37-56); said client system including a computer processor and associated memory, said client system being adapted for storing said electronic coupon in said memory (col 6, lines 22-27 and col 6, lines 37-56); a second server system connected to said communications channel, said second server system being adapted to establish a connection with said client system and for detecting said electronic coupon stored on said client system, said second server system further being adapted to redeem said electronic coupon (col 5, lines 39-46; col 6, line 57-col 7, line 4).

In addition to the USC 102 rejection for Claim 57 above, Claim 57 is rejected according to USC 112 detailed above.

Claim 48: Larson discloses a system according to claim 47. Larson further discloses a third server system connected to said communications channel, said third server system being adapted for communicating with said second server system

Art Unit: 3622

and for authorizing the redemption of said electronic coupon (col 6, lines 20-28; col 6, line 57-col 7, line 4).

Claim 49: Larson discloses a system according to claim 47. Larson further discloses that said second server system is adapted to redeem said coupon as a function of a transaction initiated between said client system and said second server system (col 6, lines 20-28; col 6, line 57-col 7, line 4).

Claim 50: Larson discloses a system according to claim 47. Larson further discloses that said second server system is adapted to redeem said coupon by modifying a transaction initiated between said client system and said second server system (col 5, lines 40-45; col 6, lines 20-28; and col 6, line 57-col 7, line 4).

Claim 51: Larson discloses a system according to claim 47. Larson further discloses that said communications channel includes a network (col 6, lines 37-48).

Claim 52: Claim 52 is rejected according to the USC 112 rejection above.

Claim 53: Larson discloses a system according to claim 47. Larson further discloses that said first server system and said second server system are the same server system (col 5, lines 40-45 and col 6, lines 22-25).

Claim 54: Larson discloses a system according to claim 47. Larson further discloses that said electronic coupon is a token issued under the authority of an issuer for the benefit of said client (col 6, lines 49-56 and col 5, lines 49-54).

Claim 55: Larson discloses a system according to claim 47. Larson further discloses that said electronic coupon includes data representative of one or more of a serial or identification number, a

Art Unit: 3622

validation key, an authentication key, an authorizing vendor, a redeeming vendor, a benefit or discount to be associated with a transaction, a level of access granted, and an issuing activity (col 6, lines 51-55 and col 5, lines 26-44).

Claim 56: Larson discloses a system according to claim 47. Larson further discloses that said electronic coupon includes data representative of the identity of a location at which additional coupon information resides (col 7, lines 5-9 and col 8, lines 59-65).

Claim 58: Claim 58 is rejected according to the USC 112 rejection above.

Claim 59: Larson discloses a system according to claim 57. Larson further discloses authenticating said electronic coupon and authorizing a transaction between said client and subsequent server as a function of an authenticated electronic coupon (col 2, lines 28-32; col 5, lines 40-45; col 1, lines 54-57; and col 4, lines 33-36).

Claim 60: Larson discloses a system according to claim 57. Larson further discloses establishing a connection between said subsequent server and an authentication server; said authentication server authenticating said electronic coupon and authorizing the redemption of said electronic coupon (col 2, lines 28-32; col 5, lines 40-45).

Conclusion

The following prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

- a. Gregory discloses a system for distributing coupons to multiple locations.

Art Unit: 3622

b. Nichtberger discloses a paperless system for distributing and redeeming coupons.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Arthur Duran whose telephone number is (703)305-4687. The examiner can normally be reached on Mon- Fri, 7:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (703)305-8469. The fax phone numbers for the organization where this application or proceeding is assigned are (703)872-9326 for regular communications and (703)872-9327 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)308-1113.

AD

November 4, 2002


APPROVED
JOHN J. LOVE
DIRECTOR TC 3600